

REMARKS

This amendment responds to the office action dated April 9, 2008.

The Examiner objected to claim 13, contending that the term “pixel value” is not normally considered a “statistical measure.” The applicant has amended independent claim 12 to recite a first “statistic” and has amended claim 13 to recite that the first “statistic” is the “intensity value” of the pixel in the first channel. The applicant’s previous response included a dictionary definition of the word “statistic” that encompasses the claimed “intensity value”, i.e. a “statistic” is defined as “a single term or datum in a collection of statistics” where the term “statistics” refers to a “collection of quantitative data.” Thus, in a multi-channel digital image comprising a plurality of pixels, each pixel has an intensity value in each of those respective channels, e.g. a red intensity, a green intensity, and a blue intensity. Thus, the set of intensity values for the pixel is a collection of “statistics” and each of the intensity values is a “statistic” in that collection

The Examiner is reading the term “statistic” in terms of another definition, i.e. “a quantity . . . computed from a statistical sample as an estimate of a population parameter.” However, it is not proper for the Examiner to preclude the applicant from using a claim term in a manner consistent with one definition of a term, in favor of another that the Examiner believes to be more appropriate. It is the applicant that can be his or her own lexicographer. Because there is a common usage of the term “statistic” consistent with the manner in which it is used in claim 13, the applicant respectfully requests that the Examiner’s objection to claim 13 be withdrawn.

The Examiner rejected claim 13 under 35 U.S.C. § 112, second paragraph for a lack of antecedent basis for the term “the value” of said pixel. As amended, claim 13 recites “the intensity value” of said pixel. Every pixel of an image inherently has at least one intensity value, e.g. each pixel of a monochrome image has a grayscale intensity value, each pixel of a three-channel color image has three intensity values, one for each channel, etc. Thus, the applicant’s reference to “the intensity value” of said pixel is not indefinite, and the applicant respectfully requests that the Examiner’s rejection of claim 13 under 35 U.S.C. § 112 be withdrawn.

The Examiner rejected each of claims 1-5, 7-15, 17-21, and 23 under either 35 U.S.C. § 102(e) as being anticipated by Jarman, or alternately under 35 U.S.C. § 103(a) as being obvious over a combination that cites Jarman as the primary reference. The applicant, in the most previous response, submitted an affidavit removing Jarman as a prior art reference by showing a reduction to practice prior to the effective date of Jarman. The Examiner is improperly ignoring this affidavit. The Examiner asserts that the affidavit is ineffective because several pages of a copy of an invention disclosure form attached to the affidavit were printed from a computer on a date later than the effective date of Jarman. The Examiner has not provided any reasoned explanation of the relevance of the date at which an attachment to an antedating affidavit happened to printed.

To the contrary, both case law and the MPEP indicate that the Examiner's refusal to remove Jarman as a reference is improper. This authority merely requires an antedating declaration to *aver* inventorship prior to the effective date of the reference, and that the facts averred be supported by *some* documentation. *See, e.g., In re Harry*, 333, F.2d 920, 142 USPQ2d 1385, 1388 (D.D.C. 1997); *see also* MPEP at 715.07. For example, the cited portion of the MPEP states that the "essential thing to be shown . . . is priority of the invention and this may be done by *any* satisfactory evidence of the facts. FACTS, not conclusions must be alleged. Evidence in the form of exhibits *may* accompany the affidavit or declaration" (italics added). Thus, nothing in the MPEP makes a specific requirement of documentary support of an invention *date* that is sworn to in the declaration, as implied by the Examiner. To the contrary, the purpose of the requirement of documentation is to show *what* was achieved rather than *when* it was achieved. *See, e.g. Ex Parte Sanders*, 1883 C.D. 23 (1883) ("stating that the requirement of documentation is justified because the issue of whether prototypes, descriptions, and drawings embody the claimed invention is subjective and the patent office is entitled to review that decision independently, irrespective of whether the inventor actually believes himself that the prior activities embodied the claimed invention). Thus, while documentation is required to independently evaluate the subjective issue of *what* was invented, the issue of *when* the invention was reduced to practice is *not* subjective, and a sworn assertion of the date is to be accepted by the patent office. *See* MPEP § 715.07 (applicant may *allege* that the date of documented reduction to practice was prior to reference)(emphasis added); *Herman v. William Brooks Shoe*

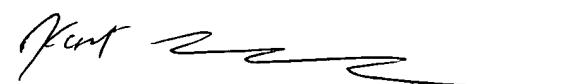
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Co., 39 U.S.P.Q.2d 1773,1777 (S.D.N.Y. 1996)(patent office must accept allegations in statement at face value without investigation). In fact, this must be true because the applicant is allowed to redact any dates in accompanying documentation, as the applicant did with respect to precise date that the invention was reduced to practice. Thus, the Examiner's implication that the sworn statement of a prior reduction to practice of the subject matter in the invention disclosure form is insufficient, absent a showing that the entire *particular printed copy* of the invention disclosure form submitted to the patent office existed prior to the cited reference conflicts with both Patent Office procedure and case authority.

The applicant's affidavit included the sworn statement that the inventions disclosed in the attachment (the invention disclosure form) were reduced to practice as of a date prior to the effective date of Jarman. Given that statement, the Examiner is required to remove Jarman as a reference. Because Jarman has been removed as a reference, the applicant respectfully requests that all prior art rejections be withdrawn.

In view of the foregoing amendments and remarks, the applicant respectfully requests reconsideration and allowance of claims 1-23.

Respectfully submitted,



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